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APR 12 2006

PTO/SB/21 (09-04)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

8

Application Number

10/891,555

Filing Date

10/24/2003

First Named Inventor

David C Lovetro

Art Unit

1746

Examiner Name

Carrillo, Bibi Sheridan

Attorney Docket Number

000600-016

ENCLOSURES (Check all that apply)


- ☐ Fee Transmittal Form
- ☐ Fee Attached
- ☐ Amendment/Reply
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Reply to Missing Parts/
Incomplete Application
- ☐ Reply to Missing Parts
under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a
Provisional Application
- ☐ Power of Attorney, Revocation
Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s) _____
- ☐ Landscape Table on CD

- ☐ After Allowance Communication to TC
- ☐ Appeal Communication to Board
of Appeals and Interferences
- ☒ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify
below):
- Pre-Appeal Brief Request for Review
(transmittal and 3 pages accompanying
arguments)


Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	WHITE, REDWAY & BROWN LLP		
Signature			
Printed name	DAVID J SERBIN		
Date	04/12/2006	Reg. No.	30,589

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature			
Typed or printed name	DAVID J SERBIN	Date	04/12/2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) <div style="text-align: right; font-family: cursive;">000600-016</div>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on <u>April 12, 2006</u> Signature <u>David J. Serbin</u> Typed or printed name <u>DAVID J SERBIN</u>		Application Number <div style="text-align: center; font-family: cursive;">10/691,555</div> Filed <div style="text-align: center; font-family: cursive;">10/24/2003</div> First Named Inventor <div style="text-align: center; font-family: cursive;">David C. Lovetro</div> Art Unit <div style="text-align: center; font-family: cursive;">1746</div> Examiner <div style="text-align: center; font-family: cursive;">Carrillo, Bibi</div>	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,589</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		<div style="text-align: center; font-family: cursive; font-size: 1.2em;">David J. Serbin</div> _____ Signature <div style="text-align: center; font-family: cursive;">DAVID J. SERBIN</div> _____ Typed or printed name <div style="text-align: center; font-family: cursive;">703 299 0035</div> _____ Telephone number <div style="text-align: center; font-family: cursive;">04/12/2006</div> _____ Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APR 12 2006

In re Patent Application of

Attorney Docket No. 000600-016

David C. Lovetro

Confirmation No. 7490

Application No. 10/691,555

Group Art Unit: 1746

Filed: October 24, 2003

Examiner: Bibi Sharidan Carrillo

For: CHEMICAL COMPOSITION AND
METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants request a review of the Final Rejection mailed December 12, 2005 in view of
the following remarks.

Patent
Attorney's Docket No. 000600-016

REMARKS

Reference is made to appellants' response to the Final Rejection filed March 21, 2006, and specifically to the arguments beginning on page 7, line 12 wherein the rejections are discussed.

The claimed invention relates to a method for cleaning metals. One of the primary references cited by the Examiner is Brasch, U.S. Patent No. 4378270. Brasch relates to a method of etching copper, and is specifically directed to a post etching method and composition which aids in the recovery of copper from the spent etching solution.

The cleaning of metals is fundamentally different from the etching of metals, as appellants point out in their specification at page 3, lines 22-24. Etching is the purposeful removal of metal from the substrate surface. By contrast, a cleaning process does not remove significant amounts of metal from the substrate, only impurities at the substrate surface. This fundamental difference between etching and cleaning is so well known that it hardly requires supporting extrinsic evidence. Nevertheless, from Webster's II New College Dictionary, Houghton Mifflin Co. (1995), come the following definitions:

Etching: *To cut into the surface of by the action of acid...*

Cleaning: *To rid of dirt; to free of impurities...*

In her Final Rejection, the Examiner, against all objective evidence, concludes that etching and cleaning are equivalent. She then uses this "equivalency" as a basis for applying Brasch, either alone or in combination with other references. Clearly the rejections based on Brasch are not proper and are without basis, since there is no teaching in Brasch of *cleaning* a metal, as claimed by appellants.

Patent
Attorney's Docket No. 000600-016

The Examiner also rejects the claims based on newly cited primary reference Sugihara et al., U.S. Patent No. 5705089. Sugihara et al. is even further afield, since it lacks any mention of treating metals of any sort. This reference is instead directed to the cleaning of a semiconductor substrate. Furthermore, as the Examiner readily admits, Sugihara et al. "fails to teach the claimed concentration of phosphonic acid." So, not only does Sugihara et al. fail to teach the cleaning of metals, it fails to teach appellants' claimed cleaning composition used in the method. To allege a *prima facie* case of obviousness, therefore, the Examiner must imagine the skilled artisan using a *composition* different from Sugihara et al. for a *purpose* different from Sugihara et al. (i.e., cleaning of metals.)

Clearly the rejections based on Sugihara et al., either alone or in combination, are not proper and are without basis, since there is no teaching in Sugihara et al. of cleaning a *metal*, using a *composition as claimed by appellants*.

For the above reasons, it is respectfully requested that the rejections be withdrawn.

The Commissioner is authorized to charge any fees associated with the filing of this paper to Deposit Account No. 503015.

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Date: April 12, 2006

Respectfully submitted,

WHITE, REDWAY & BROWN LLP

By: 

David J. Serbin

Registration No. 30,589